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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,357	09/24/2001	Nicholas F. D'Antonio	DA7119US (#90036)	7922

28672 7590 04/11/2003
D. PETER HOCHBERG CO. L.P.A.
1940 EAST 6TH STREET
CLEVELAND, OH 44114

EXAMINER

LAM, ANN Y

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/937,357	Applicant(s) D'ANTONIO ET AL. <i>MM</i>
Examiner Ann Y. Lam	Art Unit 3763	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 September 2001 and 01 April 2002 .

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-63 is/are pending in the application.
4a) Of the above claim(s) 36-47 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-35 and 48-63 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
4) Interview Summary (PTO-413) Paper No(s). ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-35, drawn to an injection device classified in class 604, subclass 191.
- II. Claims 36-47, drawn to a station for re-energizing an injection system, classified in class 604, subclass 235.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination of the injection device and loading station do not require the particular claimed elements in the subcombination as claimed. The subcombination has separate utility such as loading an injection device different from the one claimed by Applicant in the combination.

During a telephone conversation with Peter Hochberg on March 20, 2003 a provisional election was made without traverse to prosecute the invention of Invention I, claims 1-35. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 26-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18, 20-35, 47-54, 56, 57, 59, 60, 61-63 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Antonio et al., 6,056,716.

D'Antonio et al. discloses a housing (913), a container-holding member (921) for holding injectate containers; and a latching and release apparatus (see column 23, lines 12-17) for latching holding member to housing and for releasing said holding member and the container held by said holding member from said housing without any physical contact by the user.

As to claim 2, 12, 13, 21, the housing houses at least two injectate containers (800), and holding member has openings, see Figure 7A.

As to claim 3, 22, guard walls (805) are provided around said openings.

As to claim 4, splash guard walls (919) are provided around container-holding member.

As to claim 5, the openings are press fit with injectate containers, see column 22, lines 47-66, and see Figure 7A.

As to claim 6, 10, 11, holding member comprises a front plate and said latching and release apparatus includes a groove (919) in one of said housing and a latching member in front plate, see column 22, lines 57-67.

As to claim 7, an actuatable injectate release device (703) and trigger (701) for actuating said injectate release device is disclosed.

As to claims 8, 9, said injectate release device comprises a spring (227), and latch for holding spring in set condition, see column 16, lines 40-49.

As to claim 14, one of the cartridges (800) are considered non-functional channels.

As to claim 15, the cartridge comprises an outer wall (812) defining a chamber; a plunger (802) in said chamber.

As to claim 16, said cartridges comprises a rupturable seal, see column 27, line 58 – column 28, line 5.

As to claim 17, a device (702) for rupturing said seal is disclosed.

As to claim 18, a biasing device (874) to force the injectate out of the containers is disclosed.

As to claim 20, the cartridges have perforators (882), and see column 27, lines 65-67.

As to claims 23, 24, 31, 32, a ram apparatus (224), a carriage for moving said ram apparatus; a spring apparatus (227) for moving said carriage; a carriage resetting

apparatus (436) for moving said carriage to the set position, and for recocking said spring apparatus, and a releasable latching device for latching said spring apparatus is disclosed, see column 10, lines 46-59.

As to claim 25, a guard plate (805) is disclosed.

As to claims 26, 29, a cam and cam follower as claimed is disclosed, see column 10, lines 46-59.

As to claims 27 and 28, a spring apparatus with movable rods (228 and 229) and latching members (238 and 239) as claimed are disclosed in column 10, line 66 – column 11, line 13.

As to claim 30, a solenoid as claimed is disclosed at (48).

As to claim 33, a housing (220), a handle (991) attached to said housing, a motor (221), a movable tool driven by motor, a power input apparatus for supplying electric power to motor is disclosed, see column 9, line 63 – column 10, line 17.

As to claim 34, a loading station to operate said carriage resetting apparatus is disclosed, see column 10, lines 10-17.

As to claim 35, a sensing apparatus as claimed is disclosed in column 24, lines 24-27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 55 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio et al., 6,056,716.

D'Antonio et al. discloses the invention substantially as claimed, see above, except for there being six cartridges. D'Antonio discloses five cartridges and providing a device with six cartridges would not depart from the scope of the invention, see column 30, lines 43-46 and would have been obvious to one of ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is (703) 306-5560. The examiner can normally be reached on T-F 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (703)308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

A.L.
March 24, 2003



BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700